

### Remarks

In view of the following amendments and remarks, favorable reconsideration of the outstanding office action is respectfully requested. Claims 1 – 29 remain in this application. Claim 1 has been amended.

#### **1. Allowed Claims/Subject Matter**

Applicant notes with appreciation that the Examiner has indicated the subject matter of claims 3 – 7 and 28 is patentable, and would be allowable if rewritten in independent form.

#### **2. Claim Objections**

The Examiner has objected to claim 1 because of certain informalities. In particular, the Examiner points out the term “a remote use indictor” should be “a remote use indicator.” The applicant has amended claim 1 in response to the Examiner’s objection.

#### **3. § 102 Rejections**

The Examiner has rejected claims 1, 2, 8, 10 – 12, and 14 – 17 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,667,073 to Osika.

Claim 1 is directed to an electrical device for use in an electric circuit. The device includes a housing, a remote use indicator, and an indicia holder. At least one wiring device is disposed within the housing. The at least one wiring device includes an electrical switch. The electrical switch includes at least one terminal member configured to be coupled to the electric circuit. The electrical switch is configured to selectively energize at least one load. A remote use indictor module is disposed within the housing. The remote use indicator module includes a remote use indicator circuit that is coupled to the electrical switch and a remote use indicator coupled to the remote use indicator circuit. The remote use indicator circuit is configured to detect when the at least one load is energized and/or de-energized, and actuate the remote use indicator in response thereto. An indicia holder is disposed in the housing. The indicia holder is configured to display a removable indicia identifying a remote location of the at least one load and/or an ornamental image, the indicia being tactile or visual in nature.

Osika is directed to an electrical toggle switch configured to be plugged into a receptacle of an electrical equipment. The switch displays the operating condition of the

switch and the electrical equipment controlled thereby. The switch may be of the single pole double throw type, or the double pole double throw type, operated by a three position toggle lever which actuates a fulcrum mounted conductive bridge. The switch housing incorporates indicating lamps with color coded lenses. A legend plate assembly mounted on the switch includes a readily interchangeable legend plate which indicates the switch function whether or not specifically illuminated.

According to **MPEP 2131**, “to anticipate a claim, the reference must teach every element of the claim.” A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

With regard to independent claim 1, the Examiner does not make a prima facie case for anticipation because he does not show were the cited art discloses every element of the claims. For example, the Examiner asserts that Osika discloses *at least one wiring device* disposed in a housing. In particular, the Examiner states that Osika’s switch element 20 is, or includes, “a wiring device having at least one terminal.” However, the claim recites “a wiring device having at least one terminal configured to be coupled to an electric circuit, the electrical switch being configured to selectively energize at least one load.” As such, the Examiner does not consider all of the elements of the claim. Osika’s terminals (22, 23, 24) are plug in blades that are configured to be mated with a receptacle fitting disposed on an equipment control panel. See Col. 4, line 60 – col. 5, line 7. A wiring device, on the other hand, is recognized by those skilled in the art as a term that refers to wall mounted devices employed in the electric circuits disposed in commercial and/or residential structures. Such devices are referred to as wiring devices because they include line terminals configured to be connected to wires coupled to the distribution panel (AC power) and load terminals configured to be connected to wires coupled to one or more remote loads. Osika does not disclose this type of device. Accordingly, Osika does not disclose the “at least one wiring device” recited in the claim.

The Examiner argues that Osika discloses a remote indicator module as recited in claim 1. The recited module includes a remote use indicator circuit and a remote use indicator. The Examiner asserts that elements A and B, shown in Figures 6 – 8 are remote indicator modules. However, Osika describes these elements as lamp A and lamp B. These lamps are described as being directly connected to a power source. Osika states that the

lamps indicate the state of the switch 20. See col. 4, lines 33 – 49. A fair reading of Osika reveals that Osika's switch plugs directly into a piece of equipment. On the other hand, the claim recites a remote use circuit that detects when a remote load is energized or de-energized. Lamps A and B only indicate if the switch is on or off., they do not detect the status of a remote load.

The Examiner admits that Osika does not include a remote use circuit. To get around this deficiency, the Examiner asserts that the circuit is "inherent" because "means for providing a voltage is disclosed and...some type of circuit must be present..." MPEP 2132.01 provides the following case law regarding inherency:

"To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

According to the Federal Circuit, the Examiner must provide extrinsic evidence that shows that an inherent characteristic is necessarily present in the reference. Applicant respectfully points out the Examiner has provided no extrinsic evidence. The Examiner makes an assertion, but provides no evidence in support of his assertion. Second, a remote use circuit is not a characteristic of a thing, it is a thing – either Osika has such a circuit or it does not. In this case, it does not have the recited claim element. Third, the Examiner's reasoning is internally contradictory because he fails to provide any reason why one skilled in the art would deem Lamps A, B to inherently include a remote use circuit. In particular, the Examiner argues that because a "voltage" is provided to Lamps A, B, "some type of circuit must be present." The applicant respectfully points out that "some type of circuit" does not necessarily include a remote use circuit.

The Examiner points to element 83 as being an indicia holder configured to display a removable indicia identifying a remote location of the at least one load and/or an ornamental image, as recited by claim 1. Claim 1 also recites that the indicia may be *tactile* or *visual* in nature. Element 83 is disclosed relative to Figures 9 – 11 of Osika. This embodiment shows a legend plate assembly that indicates whether switch 20 is ON or OFF. The legend plate does

not show a remote location corresponding to the location of a remote load, as substantially recited in claim 1. It does not show a remote use indicator module. Further, the Examiner fails to point out where Osika discloses an indicia holder that is either tactile or visual.

Expanding on a point made in the previous paragraph, the applicant notes that Osika fails to disclose all of the features of the claimed invention in one embodiment. The Examiner unfairly mixes and matches these embodiments to arrive at the claimed invention. In other words, Figure 1 of Osika discloses a switch and two indicator lamps. This embodiment cannot accommodate an additional indicia holder because there is no more space on the front surface of the device. In the second embodiment, shown in Figures 9 – 11, Osika discloses a switch and an indicia holder. This embodiment does not accommodate a separate lamp. Accordingly, Osika does not disclose an embodiment that can accommodate a switch, a remote use indicator module and an indicia holder in a single device.

Accordingly, the Examiner has not shown where Osika discloses every element recited in claim 1. The dependent claims are allowable by virtue of their dependency from claim 1, and also allowable in their own right. For example, Osika does not employ light emitting diodes (claim 8) responsive to the remote use circuit (claim 14). Nor does Osika disclose a remote use indicator that provides a color coded light signal.

The Examiner has not made a prima facie case of anticipation because he has not shown where Osika discloses each and every element of the claimed invention. Accordingly claims 1, 2, 8, 10 – 12, and 14 – 17 are patentable under 35 U.S.C. § 102(b). The applicant respectfully requests that the rejection under 35 U.S.C. § 102(b) be withdrawn.

#### **4. § 103 Rejections**

The Examiner has rejected claims 9, 13, 18 – 27, and 29 under 35 U.S.C. § 103 as being unpatentable for obviousness over Osika.

Claim 18 is directed to electrical device for use in an electric circuit. The device includes a housing having a planar surface of at least 0.8 square inches in area. At least one wiring device is disposed within the housing. The at least one wiring device includes an electrical switch. The electrical switch includes at least one terminal member configured to be coupled to the electric circuit. The electrical switch is configured to selectively energize at least one remote load. An indicia holder is disposed on the planar surface of the housing, and

is configured to display an indicia identifying the remote load selectively energized by the at least one wiring device disposed within the housing.

According to the **MPEP 2143**, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

**A. The prior art references do not teach or suggest all the claim limitations.**

**Claims 9 and 13:**

In the analysis provided in Section 3 above, the applicant has pointed out the Osika does not disclose every element of claim 1. Accordingly, claim 9 and claim 13 are allowable by virtue of their dependency from claim 1. These claims are also allowable in their own right. The Examiner has failed to point out where Osika teaches or suggests using a neon lamp as a remote indicator, as recited in claim 9. Further, the Examiner has failed to point out where Osika teaches a removable indicia that includes both text and at least one image. The Examiner's motivation to modify Osika is discussed in Section 4.B, below.

**Claims 18 – 25, 27, and 29:**

With regard to independent claim 18, the Examiner does not make a *prima facie* case of obviousness because he does not show where the cited art teaches or suggests every element of the claim.

The Examiner fails to show where Osika teaches a housing having a planar surface that is at least 0.8 inches. Reading the claim in its entirety, the planar surface must accommodate the indicia holder. The Examiner admits that Osika does not include this feature. Rather, he asserts that this dimension is a matter of design choice. The Applicant discusses this assertion in Section 4.B below.

The Examiner also asserts that Osika discloses *at least one wiring device* disposed in a housing, as recited by claim 18. In particular, the Examiner states that Osika's switch element 20 is, or includes, a wiring device having at least one terminal configured to be coupled to an electric circuit and selectively energize at least one load. However, Osika's terminals (22, 23, 24) are plug in blades that are configured to be mated with a receptacle fitting disposed on an equipment control panel. See Col. 4, line 60 – col. 5, line 7. A wiring device, on the other hand, is recognized by those skilled in the art as a term that refers to wall mounted devices employed in the electric circuits disposed in commercial and/or residential structures. In particular, such devices are referred to as wiring devices because they include line terminals configured to be connected to wires coupled to the distribution panel (AC power) and load terminals configured to be connected to wires coupled to one or more remote loads. Osika does not disclose this type of device.

The Examiner points to element 83 as being an indicia holder disposed on the planar surface, as recited by claim 18. As noted previously, element 83 is disclosed relative to Figures 9 – 11 of Osika. This embodiment shows a legend plate assembly that indicates whether switch 20 is ON or OFF. The legend plate does not show a remote location identifying the location of a remote load, as recited in claim 18. Further, by carefully reading the claim and considering the claim in its entirety, the indicia holder must be at least 0.8 inches because it is disposed on the planar surface. The Examiner does not show where this claim limitation is found in Osika.

The claims depending from claim 18 are allowable by virtue of their dependency from claim 18, but are also allowable in their own right. For example, claim 19 recites that the indicia holder is configured to provide tactile indicia. The Examiner fails to show where this feature is taught or suggested by Osika. Claim 20 recites that the indicia holder includes both tactile indicia and human readable indicia. The Examiner fails to show where Osika includes this limitation either. Claim 27 recites that the housing further comprises a receptacle. Claim 28 recites that the housing further comprises a timer. Again, the Examiner fails to show where Osika teaches or suggests any of these claim limitations.

**B. There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.**

**Claims 9 and 13:**

The Examiner admits that Osika does not teach or suggest the subject matter of claim 9 and claim 13. However, the Examiner provides boilerplate from *Ex Parte Masham*: “*the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitation.*” The applicant respectfully points out that Mesham is not applicable here because the subject matter of claim 9 and claim 13 is not directed to an intended manner of usage. Further, the cited reference, Osika, does not satisfy all the structural limitations. Claim 9 includes a remote use indicator having at least one neon lamp – Osika does not have this element and this claim says nothing regarding intended usage. Claim 13 recites an indicia having both text and imagery. Osika does not have this structural limitation and the claim says nothing about intended usage.

Accordingly, the Examiner’s rationale for modifying Osika to include the claimed subject matter does not meet the standards provided by MPEP 2143 because he fails to show any suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the Osika reference.

**Claims 18 – 25, 27, and 29:**

1. The Examiner admits that Osika does not include a housing having a planar surface of at least 0.8 inches to accommodate an indicia holder. Rather, he asserts that this dimension is a matter of design choice because the modification only involves a “mere change” in the size of a component. He relies on *In re Rose* for the proposition that a change in size of a component is recognized as being within the level of ordinary skill in the art. However, the Examiner’s reliance on *Rose* is misguided because he does not properly apply *Rose*. *Rose* refers to the process of making discrete stand alone components smaller. In this case, the size of the wiring device is fixed. It must fit into a wall box mounted on a stud within a building structure. Accordingly, the process of designing a wiring device to accommodate an indicia holder having a surface area of at least 0.8 inches within a housing of a fixed size is not a mere design choice.

Further, the Examiner does not employ the “design choice” argument in accordance with the standards recognized by the U.S.P.T.O. The design choice argument is a result of *Ex Parte Garret* (B.P.A.I., 1986). The Examiner should refer to this case and apply the proper

test for his design choice argument. Essentially, the Examiner must show that any number of design choices would work equally well with each other.

2. The Examiner provides no motivation for modifying the device taught by Osika to include electrical wiring devices. According to **MPEP 2143**, a prima facie case of obviousness requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. In this case, the Examiner does not address this part of the test for obviousness.

### **C. Summary**

The Examiner has not made a prima facie case of obviousness because he has not shown where Osika teaches or suggests all the claim limitations. Further, the Examiner has not provided a valid suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the Osika reference. Accordingly claims 9, 13, 18 – 27, and 29 are patentable under 35 U.S.C. § 103. The applicant respectfully requests that the rejection under 35 U.S.C. § 103(a) be withdrawn.



## 5. Conclusion

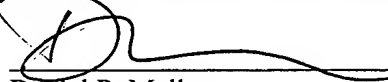
Based upon the amendments, remarks, and papers of record, Applicant believes the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record. Applicant respectfully requests reconsideration of the pending claims 1 – 29 and a prompt Notice of Allowance thereon.

Applicant believes that no extension of time is necessary to make this Response timely. Should Applicant be in error, Applicant respectfully requests that the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Response timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 50-1546.

Please direct any questions or comments to Daniel P. Malley at (607) 330-4010.

Respectfully submitted,

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